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APPEALS TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

# 34/86  
5-6-03

In re Application of: )  
)  
Gary Karlin Michelson, M.D. )  
)  
Serial No.: 08/354,450 )  
)  
Filed: December 12, 1994 )  
)  
For: DEVICE FOR ARTHROSCOPIC )  
MENISCAL REPAIR )

Group Art Unit: 3764

Examiner: D. DeMille

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

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Sir:

REPLY BRIEF

In reply to the Examiner's Answer, Appellant submits that the issues presented in Appellant's Brief of July 23, 2002 have been reduced by the Examiner's entry of Appellant's Amendment After Final filed July 23, 2002 (the "Amendment After Final") and by the Examiner's remarks in the Examiner's Answer. In particular, the Examiner did not challenge many of Appellant's points. In several instances, the Examiner attempted to refute Appellant's arguments regarding obviousness by alleging for the first time a lack of written support for a claimed element. Such allegations extend beyond the issues on appeal and constitute impermissible new grounds of rejection. (See 37 C.F.R. § 193(a)(2)).

Response to Examiner's Answer

Appellant submits the following remarks for consideration by the Board of Patent Appeals and Interferences:

**I. Entry of the Amendment After Final and the Examiner's remarks contained in the Examiner's Answer have reduced the issues on appeal**

In the Appeal Brief, Appellant presented five issues on appeal. Appellant submits that Issues 1-4 as presented in the Appeal Brief have been resolved by the entry of the Amendment After Final and the Examiner's remarks in the Examiner's Answer. In certain instances, the Examiner did not challenge Appellant's arguments. The MPEP states that "[g]rounds of rejection not argued in the examiner's answer are usually treated as having been dropped...." (MPEP § 1208, paragraph bridging pages 1200-16 and 1200-17 (August 2001)). Appellant's reply to the Examiner's remarks is grouped below to follow the issues presented for appeal in the Appeal Brief.

**Issue (1): whether claims 19-24 are patentable under 35 U.S.C. § 112, first paragraph, as being supported by the specification**

In the Office Action dated March 4, 1996 (the "March 1996 Office Action"), the Examiner noted that "the specification does support the limitation that the distance from the top of the projection to the central axis of the shaft is greater than the diameter of the head (said another way, the sum of the radius of the shaft and the height of the projections is greater than the radius of the head)." (March 1996 Office Action, page 2).

Appellant amended independent claim 19 in the Amendment After Final to recite that "said shaft and said flexible member each having a radius measured from the central longitudinal axis of said shaft, each of said flexible projections having a height measured from a surface of said shaft, the sum of the height of one of said flexible projections and the radius of said shaft being greater than the radius of said flexible member." (Amendment After Final, filed July 23, 2002).

In the Examiner's Answer, the Examiner indicated that the Amendment After

Final was entered. (Examiner's Answer, page 2, paragraph number 4). The Examiner then stated a new ground of rejection of claims 19-24 under 35 U.S.C. § 112, first paragraph, by alleging that the language Appellant inserted into claim 19 was not supported by the specification. (Examiner's Answer, page 4, lines 13-16). The Examiner's position is contrary to the statement in the March 1996 Office Action indicating that the amended language is supported by the specification. (March 1996 Office Action, page 2, lines 21-26). Appellant submits that no weight should be given to the new ground of rejection as it is beyond the scope of the issues on appeal. Appellant submits that the rejection of claims 19-24 as being unpatentable under 35 U.S.C. § 112, first paragraph, for being unsupported by the specification is overcome and that issue (1) is constructively withdrawn.

**Issue (2): whether claims 19-24, 26, and 27 are patentable under 35 U.S.C. § 112, second paragraph, as being definite**

In the Examiner's Answer, the Examiner withdrew the rejection of independent claim 19, but maintained the rejection of dependent claim 24 under 35 U.S.C. § 112, second paragraph. The Examiner did not indicate the status of the rejection of dependent claims 20-23, 26, and 27 under 35 U.S.C. § 112, second paragraph. Appellant submits that the rejection of these claims under 35 U.S.C. § 112, second paragraph, is overcome by Appellant's Amendment After Final, which was entered by the Examiner.

For claim 24, Appellant submits that the Examiner's remarks do not address Appellant's argument that claim 24 is clear and therefore definite. Thus, Appellant's argument on this point stands unchallenged.

In Section II below, Appellant addresses the Examiner's remarks concerning the

support of claim 24 in the specification, which is an issue separate from a rejection under 35 U.S.C. § 112, second paragraph.

**Issue (3): whether claims 19, 22, and 26-28 are patentable under 35 U.S.C. § 103(a) over Warren.**

**A. Points Unchallenged by the Examiner**

Independent claims 19 and 28 each recite a tissue rivet being "sufficiently flexible so as to be capable of deforming so as to conform to an angle of insertion of said rivet into the tissue and capable of deforming so as to conform to the surface of the tissue in which said rivet is inserted...."

In the Appeal Brief, Appellant submits that Warren teaches away from Appellant's claimed invention because, *inter alia*, Warren teaches the use of a fillet (which are known to reinforce a corner where two surfaces meet) at the junction of the shank and head of the Warren fastener. (Appeal Brief, page 10, second full paragraph).

The Examiner acknowledged Appellant's argument, but remarked that "there is no claim limitations [sic] precluding the presents [sic] of a fillet. ...[T]here is nothing in the specification that says the instant invention can't have a fillet." (Examiner's Answer, page 9, line 21 to page 10, line 2). Appellant submits that the presence of fillet at the junction of the shank and the head prevents the head from being flexible as claimed in Appellant's independent claims 19 and 28. The Examiner's remarks, however, do not address Appellant's argument that Warren teaches away from Appellant's claimed invention. Thus, Appellant's argument on this point stands unchallenged.

In the Appeal Brief, Appellant further argued that the Examiner used impermissible hindsight in order to fashion a motivation to support the rejection. (Appeal Brief, page 11, first full paragraph). The Examiner's Answer contains no argument

addressing Appellant's argument of impermissible hindsight. Thus, Appellant's argument on this point stands unchallenged.

For claims 26 and 27, Appellant argued in the Appeal Brief that because both rejections failed to include grounds of rejection, they were improper and had to be withdrawn. (Appeal Brief, page 12, first full paragraph, and page 13, first full paragraph). The Examiner's Answer contains no argument addressing this point relative to claims 26 and 27. Appellant further argued that even if grounds of rejection were provided, Warren teaches away from Appellant's claimed invention. The Examiner's remarks do not address Appellant's arguments that Warren teaches away from Appellant's claimed invention. Thus, Appellant's arguments on these points stand unchallenged.

The Examiner's only remarks relative to claims 26 and 27 was that he alleged that claims 26 and 27 lack support in the specification. (Examiner's Answer, page 10, third full paragraph). Any allegation of a lack of support is a separate issue from the issue of obviousness. Appellant addresses the issue of support in more detail in Sections II and III below.

#### B. Points Conceded by the Examiner

For independent claim 19, Appellant argued in the Appeal Brief that Warren fails to teach, suggest or show at least a portion of the flexible projections extending a distance from the central axis of the shaft that is greater than the width of the flexible member. (Appeal Brief, page 10, lines 1-3). The Examiner replied that "...Warren may not teach that the projections extend a greater distance than the flexible member however, appellant's invention doesn't either and therefore Warren doesn't have to

show it.” (Examiner’s Answer, page 9, lines 4-6). Appellant submits that the Examiner has constructively withdrawn the rejection of independent claim 19 by implicitly agreeing with Appellant that Warren does not fairly teach what is being claimed. Any allegation of a lack of support is a separate issue from the issue of obviousness. Appellant addresses the issue of support in more detail in Section III below.

For claim 22, Appellant argued in the Appeal Brief that the rejection over Warren was improper and had to be withdrawn because no grounds of rejection and/or motivation specific to claim 22 were provided. (Appeal Brief, page 11, last full paragraph). In the Examiner’s Answer, the Examiner admits that no grounds of rejection were supplied by stating that “no argument was given because it was understood that appellant could read the reference.” (Examiner’s Answer, page 10, second full paragraph). Thus, Appellant submits that the rejection of claim 22 is improper and must be withdrawn.

#### C. Points Challenged by the Examiner

In the Examiner’s Answer, the Examiner conceded that Warren does not describe the flexibility of the head. (Examiner’s Answer, page 9, line 8). The Examiner argued that because “appellant’s invention and Warren’s invention is made of the same material and that Warren states that the fastener is formed out of a resilient material it would appear that Warren’s fastener would comprehend the claimed invention.” (Examiner’s Answer, page 9, lines 8-11). Appellant respectfully submits that the Examiner is ignoring the fundamental design of each invention. The surgical fastener of Warren is designed to be rigid enough to withstand the repeated blows to move the fastener down a guide wire into a final position. (See Warren, col. 5, lines 8-16 and

Figs. 6-8). The head of the Warren fastener is not designed to be "sufficiently flexible so as to be capable of deforming so as to conform to an angle of insertion of said rivet into the tissue and capable of deforming so as to conform to the surface of the tissue in which said rivet is inserted . . ." as recited in independent claims 19 and 28.

In the Examiner's Answer, the Examiner contended that Appellant's rivet had to be repeatedly struck like the fastener of Warren in order to move it into place. (See Examiner's Answer, page 10, lines 3-6). Appellant respectfully submits that the Examiner's contention is in error. Appellant teaches in the specification that the rivet is "*pushed* through the meniscus M until the tear T is compressed" using driver 130. (Specification, page 7, lines 27-29 (emphasis added)). Appellant's design results in a tissue rivet that is more easy to use. (Specification, page 4, lines 26-28).

**Issue (4): whether claims 20 and 21 are patentable under 35 U.S.C. § 103 over Warren in view of Bays et al.**

**A. Point Unchallenged by the Examiner**

For claim 20, Appellant argued that the proposed combination of Warren and Bays et al. taught away from Appellant's claimed invention. (Appeal Brief, page 15, first full paragraph). The Examiner's remarks do not address Appellant's arguments that the combination of Warren and Bays et al. teaches away from Appellant's claimed invention. Thus, Appellant's argument on this point stands unchallenged.

**B. Appellant Concedes that Claim 21 Stands or Falls with Claim 20**

For claim 21, Appellant's representative conducted an interview with the Examiner on December 3, 1996. During the interview, the Examiner agreed that claim 21 defined over Bays et al. (Examiner Interview Summary Record dated December 3, 1996). In the Examiner's Answer, the Examiner has now reversed his position by

rejecting claim 21 and alleging that any difference in the smooth transition between the driving means and the conical penetration head of Bays et al. and the invention as claimed in claim 21 is a matter of degree. (Examiner's Answer, page 11, lines 5-7). In order to expedite this appeal, Appellant consents that claim 21 stands or falls with claim 20.

C. Point Challenged by the Examiner

For claim 20, Appellant argued in the Appeal Brief that the motivation supplied by the Examiner did not support the combination of Warren with Bays et al. because Warren already provided a driver. Thus, there would have been no motivation to look at Bays et al. for a driver as contended by the Examiner. (Appeal Brief, page 14, line 20 to page 15, line 2). In the Examiner's Answer, the Examiner contended that the device of Bays et al. could work with the fastener of Warren. (Examiner's Answer, paragraph bridging pages 10 and 11). The Examiner still has not provided any motivation as to why a person of ordinary skill in the art would want to replace the driver of Warren with the device of Bays et al. to place the fastener of Warren. Appellant's argument on this point has not been refuted by the Examiner.

**Issue (5): whether claims 23 and 24 are patentable under 35 U.S.C. § 103 over Warren in view of Duncan**

A. Point Unchallenged by the Examiner

For claim 24, Appellant argued in the Appeal Brief that the rejection over Warren was improper and had to be withdrawn because no grounds of rejection and/or motivation specific to claim 24 were provided. (Appeal Brief, page 17, first full paragraph). In the Examiner's Answer, the Examiner stated that "the prior art doesn't have to show it [the claimed subject matter]." (Examiner's Answer, page 11, line 21 to



page 12, line 1). The Examiner's remarks do not address Appellant's arguments that the rejection is improper due to a lack of motivation and no grounds of rejection being provided. Thus, Appellant's argument on this point stands unchallenged.

The Examiner alleged that claim 24 lacks support in the specification. Any allegation of a lack of support is a separate issue from the issue of obviousness. Appellant addresses the issue of support in more detail in Section II below.

#### B. Point Challenged by the Examiner

Claim 23 recites that the flexible projections are positioned in a radially staggered configuration along the shaft. The Examiner contended that Duncan teaches radially staggered barbs. (See Examiner's Answer, page 11, lines 18-20). Merriam-Webster's Collegiate Dictionary defines the term "stagger" as "marked by an alternating or overlapping pattern." (Merriam-Webster's Collegiate Dictionary, 3<sup>rd</sup> Ed., page 1144, col. 1 (1999)). Duncan teaches barbs being "equally spaced about the periphery of each leg." (See Duncan, col. 11, lines 26-30 and Fig. 9). The equally spaced barbs in Duncan are not in an alternating or overlapping pattern. Appellant submits that neither Warren nor Duncan teach, disclose or suggest, whether alone or in proper combination, Appellant's claimed invention as recited in claim 23.

### **II. The Examiner's allegation that former claim 19 and present claims 19, 24, 26, and 27 lack support in the specification is incorrect**

#### A. Former Claim 19

In the Examiner's Answer, the Examiner contended that Appellant's Summary of the Invention in the Appeal Brief in relation to former claim 19 was inaccurate and misleading. Appellant submits that the Examiner's remarks are incorrect. A fair reading of the specification and the drawings support Appellant's remarks in the Appeal Brief

relative to the support of former claim 19. Nonetheless, Appellant submits that the Examiner's observations on this point are no longer relevant to the present proceedings since the Examiner entered the Amendment After Final that deleted the language in dispute.

#### B. Present claim 19

In the Examiner's Answer, the Examiner contended that present claim 19 lacked support in the specification for the language added in the Amendment After Final, despite a statement in the March 1996 Office Action to the contrary. (Examiner's Answer, page 4, lines 13-16). The March 1996 Office Action states that the specification supports the limitation that the sum of the radius of the shaft and the height of the projections is greater than the radius of the head. (March 1996 Office Action, page 2, lines 21-26). Appellant submits that the subject matter of present claim 19 is supported at least by Fig. 5, which shows the sum of the height of one of the flexible projections and the radius of the shaft being greater than the radius of the flexible member. (See, for example, Fig. 5 where the forward-most projection (facing away from the line pointing to "Fig. 5") extends a greater distance away from the shaft than does the outer perimeter of the flexible member).

For support of the claimed invention in the figures, MPEP § 2163(II)(A)(3)(a) states that "[a]n Appellant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that Appellant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, [citation omitted], ("drawings alone may provide a 'written description' of an invention as required by sec. 112"); *In re Wolfensperger*, [citation omitted], (the drawings of

Appellant's specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, [citation omitted], ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner with the same limitations as the specification.")" (MPEP § 2163(II)(A)(3)(a), page 2100-161, cols. 1 and 2 (August 2001)). Appellant submits that the description, including the drawings, allows persons of ordinary skill in the art to recognize that Appellant invented what is claimed in claim 19.

#### C. Claim 24

In the Examiner's Answer, the Examiner alleged that claim 24 lacked support in the specification. In particular, the Examiner contended that if the drawings were not to scale, then the drawings would not support a claim. (Examiner's Answer, page 9, lines 2-3). Appellant traverses the Examiner's contention. Appellant submits that the subject matter of claim 24 is supported at least by Figs. 5 and 6, which show projections 116 that are radially staggered along the shaft so that no more than two apexes of the projections are in one plane perpendicular to the longitudinal axis of the shaft. (See, for example, the third projection from the leading end of the rivet in each array along the shaft in Fig. 5).

#### D. Claims 26 and 27

In the Examiner's Answer, the Examiner alleged that claims 26 and 27 lacked support in the specification. (Examiner's Answer, page 10, third full paragraph). Appellant submits that the subject matter of claims 26 and 27 are supported as indicated in the Summary of the Invention in the Appeal Brief and that no further explanation of support is necessary. (See Appeal Brief, page 4, lines 15-21).

### **III. The Examiner impermissibly raised new grounds of rejection in the Examiner's Answer**

Appellant submits that the Examiner's Answer raised three impermissible new grounds of rejection: (1) a new rejection of claims 19-24 under 35 U.S.C. § 112, first paragraph; (2) an allegation of a lack of support for claims 26 and 27; and (3) an allegation of anticipation for independent claims 19 and 28. 37 C.F.R. § 1.193(a)(2) states that "[a]n examiner's answer must not include a new ground of rejection...." (37 C.F.R. § 1.193(a)(2)).

#### **A. New Rejection of Claims 19-24 Under 35 U.S.C. § 112, First Paragraph**

Appellant filed the Amendment After Final concurrently with the Appeal Brief. For an Amendment After Final, 37 C.F.R. § 1.193(a)(2) permits the Examiner to include rejections of claims newly added or amended so long as (1) "appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal;" and (2) "the advisory action indicates which individual rejection(s) *set forth in the action from which appeal has been taken* would be used to reject the added or amended claims." (MPEP § 1208.01, page 1200-24, paragraph bridging cols. 1 and 2 (August 2001)(emphasis added); 37 C.F.R. § 1.193(a)(2)).

Appellant did not receive an Advisory Action as required by 37 C.F.R. § 1.193(a)(2) and MPEP § 1208.01 once the Amendment After Final had been entered. Further, after Appellant amended claim 19 using language that was indicated in the March 1996 Office Action as being supported by the specification, the Examiner in the Examiner's Answer reversed the earlier position and rejected claim 19, alleging that the language earlier indicated as being supported was now unsupported. (See March 1996 Office Action, page 2, lines 21-26; and Examiner's Answer, page 4, lines 13-16).

MPEP § 1208.01 cites *In re Kronig* for the proposition that “[t]here is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection.” (MPEP § 1208.01, page 1200-24, col. 1 (August 2001), citing *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)). Appellant submits that the Examiner’s reversal of position concerning the issue of support for claim 19 represents a *prima facie* new ground of rejection in which Appellant was not given “a fair opportunity to react to.” (See *In re Kronig* (cited above)).

B. Allegation that Claims 26 and 27 Lack support in the Specification

Appellant submitted arguments in the Appeal Brief to overcome the Examiner’s rejections of claims 26 and 27 under 35 U.S.C. § 103(a). However instead of addressing Appellant’s arguments on the merits under § 103(a), the Examiner alleged a lack of support for recited elements of each claim. (Examiner’s Answer, page 10, third full paragraph). Appellant submits that the Examiner’s allegation that claims 26 and 27 are not supported by the specification represent new grounds of rejection for which Appellant has not had a fair opportunity to react to.

C. Allegation of Anticipation of Independent Claims 19 and 28

In the Examiner’s Answer, the Examiner stated that “Warren discloses the same surgical rivet arrangement as that claimed by appellant. ... It is not clear exactly how the claimed rivet is different from Warren’s rivet....” (Examiner’s Answer, page 6, lines 3, 10, and 11). From the Examiner’s remarks, it is apparent that the Examiner believes that Warren anticipates rather than makes obvious claims 19 and 28. No grounds of rejection alleging anticipation were included in the March 1996 Office Action. Appellant

submits that no fair opportunity has been provided to address the alleged anticipation of claims 19 and 28 by Warren.

#### **IV. A Petition Under 37 C.F.R. § 1.181(a) is Being Filed Concurrently Herewith**

Appellant is filing concurrently herewith a Petition under 37 C.F.R. § 1.181(a) to re-open prosecution to address the Examiner's new grounds of rejection. The Board is respectfully requested to give no weight to the Examiner's remarks concerning the new rejection of claims 19-24 under 35 U.S.C. 112, first paragraph, the Examiner's allegation that claims 26 and 27 lack support, and the Examiner's implied allegation that Warren anticipates claims 19 and 28.

#### **V. Conclusion**

Appellant submits that issues 1-4 presented in Appellant's Appeal Brief have been resolved by the Examiner's entry of Appellant's Amendment After Final and by the Examiner's remarks in the Examiner's Answer. In particular, the Examiner did not challenge many of Appellant's points. Thus, the grounds of rejection not argued in the Examiner's Answer should be treated as having been dropped. In several instances, the Examiner attempted to refute Appellant's arguments regarding obviousness by alleging for the first time a lack of written support for a claimed element. Such allegations extend beyond the issues on appeal and constitute impermissible new grounds of rejection. (See 37 C.F.R. § 193(a)(2)). For issue 5, Appellant submits that this issue has been resolved in Appellant's favor in light of Appellant's remarks above.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith,

including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: 4-24-03

By: 

Amedeo F. Ferraro  
Registration No. 37,129  
Attorney for Appellant

14500 Avion Parkway, Suite 300  
Chantilly, VA 20151-1101  
Telephone: (703) 679-9300  
Facsimile: (703) 679-9303